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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,340	12/03/2001	Kaoru Torikoshi	111243	5573
25944	7590	05/19/2006	EXAMINER	
OLIFF & BERRIDGE, PLC			SHEWAREGED, BETELHEM	
P.O. BOX 19928			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22320			1774	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/998,340

Applicant(s)

TORIKOSHI, KAORU

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/3/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's response filed on 02/22/2006 has been fully considered. Claims 1 and 14 are amended, claims 2, 3 and 11 are canceled, and thus claims 1, 4-10 and 12-16 are pending. (NOTE: Claims 5-10 and 12 are withdrawn from consideration as non-elected invention).

### ***Claim Objections***

2. Claims 4 and 15 are objected to because of the following informalities: How is it possible to provide a layer i.e., glossiness controlling layer by a mechanical treatment? Furthermore, there is no support in the specification such limitation. On the other hand, there is a support for a glossiness control surface may be formed on the surface of a substrate by mechanical treatment (see page 15, line 13 thru page 16, line 9).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkar et al. (US 6,465,081 B2) in view of Kobayashi et al. (US 5,910,359).

Sarkar discloses an image receptor sheet comprising a substrate having two opposite sides, an ink receptive layer on one side of the substrate, and an ink repellent layer on the other side of the substrate, wherein the ink repellent layer is toner powder receptive so as to allow the image receptor sheet to be used in electrophotographic printers (col. 3, lines 22-32). The side of the substrate that has the ink repellent layer is equivalent to the claimed side of the substrate that the electrophotographic image is being formed. The ink receptive layer is equivalent to the claimed characteristic controlling member. The substrate and the coated layers are transparent (col. 3, line 41 and claims 3 and 8). Since all the three layers are transparent, an image that may be provided on the ink repellent toner receptive layer can be seen when viewed through the substrate. Sarkar also teaches surface treating the substrate before applying the ink receptive layer (col. 3, line 64). Sarkar does not teach organic filler as the filler in the ink receptive layer.

Kobayashi teaches a recording sheet comprising a transparent support and a transparent colorant receptive layer on the support (abstract). The colorant receptive layer comprises organic particles such as crosslinked polymer particles and water-soluble resin in a range of 1:1 to 1:10 (polymer particles: resin) (col. 12, line 58).

Sarkar and Kobayashi are analogous art because they are from the same field of endeavor that is the ink jet recording sheet art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the colorant receptive layer of Kobayashi with the invention of Sarkar so as to optimize the ink absorbing property of the layer without affecting the transparency of the recording sheet

(see col. 6, lines 43-63). The combination of Sarkar and Kobayashi teaches a colorant receptive layer that is substantially identical to the claimed characteristic controlling member, the layer inherently functions as glossiness controlling layer that controls glossiness.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.S.  
May 13, 2006.

  
BETELHEM SHEWAREGED  
PRIMARY EXAMINER